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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial Number: 09/849,315

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Inventor: Joseph J. Solon



Atty Docket 4025

Art Unit 1772

Examiner Alexander S. Thomas

For: Environmentally Safe Method and Apparatus for Storage of Discarded Tire Rubber

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TC 1700

To: THE COMMISSIONER OF PATENTS AND TRADEMARKS

Dear Sir,

Re: Response timely made within two months after the Final Rejection of Oct.30, 2002

This timely responds within two months to the Final Rejection of Oct. 20, 2002, and therefore a timely reply is expected to permit appeal if necessary before the expiration of the three month period.

Reference is made now to the Examiner's rejection sections 1-4:

1. WITHDRAWAL OF Claims 18-21

Cancel Claims 18-21 without prejudice. This fully overcomes this item as a rejection ground.

2./3. Rejection of Claims 1 (Amended), 2, 9 (Amended) 10, 11, 13, 15, 17 and 24 (Amended) under 35 U.S.C. 103(a) over Miller in view of Pignataro

The rejection of these claims now retained is respectfully traversed, as follows more persuasively in view of the Examiner's position that "The arguments have been considered but are not deemed to be persuasive."

Thus, the enclosed DECLARATION UNDER 37 CFR 1.132 TRAVERSING THE EXAMINER'S REJECTION GROUNDS and the hereinafter proposed explicit reasons fully overcome the rejection grounds, so that allowance of each of these claims is merited, and thus a favorable action is respectfully solicited.

Comments regarding the DECLARATION:

The DECLARATION facts speak for themselves in overcoming the Examiner's conclusion necessary to sustain his rejection of these claims, namely: "Applicant also argues that Miller does not disclose the method step of preventing the accumulation of water in the strips. However Miller clearly discloses stacking the tire mats to form a generally solid form and therefore would inherently prevent the accumulation of water".

This conclusion was addressed specifically to reject Claim 1 (Amended) and Claims 2, 9 (Amended), 10, 11, 13, and 15 dependant thereupon. These Claims commonly define the method step limitations of "stacking a plurality of stacks of said (substantially) flat sections (of tire tread strips excluding sidewalls) in compact rubber-to-rubber interfacing configurations".

The DECLARATION facts establish that Miller neither provides applicant's claimed substantially flat sections, because of Miller's required integral tread-sidewall structure and the impossibility of forming flat sections from the combined tread-sidewall structure. Also established is the fact that applicant's claimed flat storage sections in "compact rubber-to-rubber interfacing configurations" (which critical structure eliminates void cavities that can accumulate water for breeding mosquitos) cannot be achieved by

the Miller integral tread-sidewall structure.

Further the Declaration establishes the facts that what Miller structure the Examiner apparently characterizes as "a generally solid form", is rather misrepresented as shown in Miller's Figures 4-6, and conversely is a form interposed with many internal cavities formed inherently by the necessary Miller structure requiring the thicker tread portions to be integrally merged with the much thinner sidewall portions. Thus, Miller's mats with attached sidewalls are not applicant's claimed *substantially flat storable sections of tire tread strips*. Neither do Miller's mats bundled together by bands form applicant's claimed tire tread strip storable sections *stacked in compact rubber-to-rubber interfacing configurations* as that critical structure eliminating Miller's internal cavities and functioning to prevent the accumulation of stale water when stored in dumps in the outside environment. Thus, the Examiner's 35 U.S.C. 103 rejection ground has failed to establish the necessitated prima-facie case of obviousness.

In contrast with the inherencies of the Miller teachings, these rejected method Claims 1 (Amended), 2, 10, 11, 13, and 15 define different method steps in a manner precluded explicitly by Miller, namely by defining *tire tread strips excluding sidewalls* whereas Miller contrariwise requires integral tread-sidewall mat structure. In view of such claimed limitations in the rejected claims the Examiner has not exercised his burden of establishing a prima-facie case of obviousness under 35 USC 103, as set forth in case law citations hereinafter, either in Miller taken alone or in view of Pignataro. Pignataro does not teach that Miller should have the *mats* modified to form stacked layers of tire

treads devoid of sidewalls stored and transported on pallets. To satisfy 35 U.S.C. 103 obviousness Pignataro would be required to suggest the explicit manner that Miller might be modified to get Applicant's claimed method, which uniquely piles the tread *strip* sections without the integral sidewalls in a compact structure to eliminate Miller's inherent internal cavities thus solving the mosquito breeding grounds problem acknowledged to exist in tire carcasses heretofore stored in the environment as characterized by Pignataro at col. 1, lines 35-42. Miller also acknowledges that tire carcasses are discarded in garbage dumps where they often collect stagnant water and serve as breeding grounds for mosquitos, col 4, lines 37-42, without anywhere teaching how to avoid such stagnant water in outside environmental storage sites. Only applicant provides and makes obvious the method of avoiding the stagnant water in old tire casings stored in the environment, thus uniquely solving the problem acknowledged but not solved in the cited references.

See the following summary of the Examiner's need to establish a *prima facie* case of obviousness by teachings in the references rather than by presumptions of the Examiner not found in the references:

In proceedings before the Patent and Office, the examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art *would lead* that individual to combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Indeed the teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 723 F.2d